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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,001	08/01/2003	Walter Harvey Waddell	2003B079	8961

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EXXONMOBIL CHEMICAL COMPANY
5200 BAYWAY DRIVE
P.O. BOX 2149
BAYTOWN, TX 77522-2149

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/633,001	Applicant(s) WADDELL ET AL.	
	Examiner Vickey Ronesi	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 and 45-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 and 45-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-43 and 45-80 are now pending in the application.
2. The objections to the title and claims have been withdrawn in light of applicants' amendment filed 2/14/2005 (page 14).
3. The 35 USC 112(2) rejection over claims 7, 11, 12, 33-35, 51, 52, 59, 63, 64, 69, and 72 has been withdrawn in light of applicants' amendment filed 2/14/2005 (page 15).
4. The terminal disclaimer filed on 2/14/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,626,219 or copending Application No. 10/398,301 has been reviewed and is accepted. The terminal disclaimer has been recorded. The obviousness-type double patenting rejections have therefore been withdrawn. The corresponding 35 USC 103(a) rejection over U.S. patent No. 6,626,219 is withdrawn in light of applicants' submission on page 16 of the amendment filed 2/14/2005 that the instant application and U.S. Patent No. 6,626,219 were commonly owned at the time the invention was made (page 16).
5. The new grounds of rejection and claim objections set forth below is necessitated by applicants' amendment. Thus, this action is properly made FINAL.

Claim Objections

6. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claim 5 recites that "the carbon black is present 10 to 200 phr"

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and claim 6 recites that “the carbon black is present at 20-180 phr”, both of which have portions that are clearly outside the range “80 or more parts per hundred rubber of the carbon black” recited in claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1, 27, 46, 58, and 70-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1, 27, 46, 58, and 70-72, the specification does not support an open-ended amount of carbon black (i.e., “80 or more part per hundred rubber of the carbon black”). Support is given on page 25, [0068] for amounts 10-200 phr, 20-180 phr, 30-160 phr, and 40-140 phr of carbon black. See MPEP 2163.05 and *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It is noted that support for the endpoint 80 phr is given on page 50, Table 9 of applicants’ specification.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

8. Claims 1-25, 27-35, 38-43, 46-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Dias et al (WO 02/48257 A2).

The rejection is adequately set forth in paragraph 5 of Office Action mailed 11/4/2004 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

9. Claims 26, 36, 37, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (WO 02/48257) in view of Kay (EP 0 376 558).

The rejection is adequately set forth in paragraph 6 of Office Action mailed 11/4/2004 and is incorporated here by reference.

Response to Arguments

10. Applicants' arguments filed 2/14/2005 have been fully considered but they are not persuasive. Specifically, applicants argue (A) that although "Dias discloses some overlapping ranges of carbon black," Dias et al does not disclose with sufficient specificity the presently claimed amount of carbon black (page 15) and (B) that Dias et al does not disclose specific examples of the applicants' claimed range (page 15, footnote).

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With respect to argument (A), it is the examiner's position that the amount of carbon black disclosed by Dias et al of 10-150 phr substantially overlaps the presently claimed range of 80-200 phr and therefore discloses with sufficient specificity the presently claimed amount of carbon black. In particular the range of 80-150 phr is common to both Dias et al and the present invention.

With respect to argument (B), case law holds that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Correspondence

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/10/2005

vr



Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700